

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Gregory Joseph Badros et al.	Art Unit :	2167
Patent No. :	7,523,096	Examiner :	Cheryl Renea Lewis
Issue Date :	April 21, 2009	Conf. No. :	5579
Serial No. :	10/726,410		
Filed :	December 3, 2003		
Title :	METHODS AND SYSTEMS FOR PERSONALIZED NETWORK SEARCHING "GOOGLEMARK"		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 408 to 574 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: June 16, 2009

Applicant : Gregory Joseph Badros et al.
Patent No. : 7,523,096
Issued : April 21, 2009
Serial No. : 10/726,410
Filed : December 3, 2003
Page : 2 of 5

35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before February 3, 2005 (the date that is fourteen months after December 3, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on June 14, 2006, thereby according a PTO Delay of 496 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from February 4, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to June 14, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patent issuance was due on or before February 14, 2009 (the date that is four months after October 14, 2008, the date on which the issue fee was paid in full and all outstanding requirements were satisfied). The PTO issued a patent on April 21, 2009, according a PTO Delay of 0 days. Patentee respectfully submits that the PTO’s calculation of PTO Delay contains an error and requests that the Office recalculate the PTO Delay for this “A Delay” as 66 days, from February 15, 2009 (the day after the date that is four months after the date on which the issue fee was paid), to April 21, 2009 (the day on which the patent issued).

See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 562 days.

“B Delay”

The period beginning on December 4, 2006 (the day after the date that is three years after December 3, 2003, the date on which the application was filed), and ending April 21, 2009 (the date the patent was issued), is 870 days in length.

Applicant : Gregory Joseph Badros et al.
Patent No. : 7,523,096
Issued : April 21, 2009
Serial No. : 10/726,410
Filed : December 3, 2003
Page : 3 of 5

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on March 13, 2007, and the patent issued on April 21, 2009, resulting in a period of 770 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 100 days (i.e., 870 days minus 770 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 100 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of “A Delay” and “B Delay”

As detailed above, “A Delay” accumulated during the following period:

February 4, 2005, to June 14, 2006; and

February 15, 2009, to April 21, 2009.

As detailed above, “B Delay” accumulated during the following period:

December 4, 2006, to March 13, 2007.

As such, the periods of “A Delay” and “B Delay” do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to a Notice to File Missing Parts was due on or before June 5, 2004 (the date that is three months after March 5, 2004, the date on which the Notice to File Missing Parts was mailed). Patentee filed a response to the Notice to File Missing Parts on August 5, 2004, thereby

Applicant : Gregory Joseph Badros et al.
Patent No. : 7,523,096
Issued : April 21, 2009
Serial No. : 10/726,410
Filed : December 3, 2003
Page : 4 of 5

according an Applicant Delay of 61 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 6, 2004 (the day after the date that is three months after the date on which the Notice to File Missing Parts was mailed), to August 5, 2004.

See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before August 31, 2007 (the date that is three months after May 31, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 27, 2007, thereby according an Applicant Delay of 27 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from September 1, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to September 27, 2007. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 88 days (i.e., the sum of 61 days and 27 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 408 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 662 days (i.e., the sum of 562 days of "A Delay" and 100 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 88 days (i.e., the sum of 61 days and 27 days); and
- 3) Total PTA should be calculated as 574 days.

Applicant : Gregory Joseph Badros et al.
Patent No. : 7,523,096
Issued : April 21, 2009
Serial No. : 10/726,410
Filed : December 3, 2003
Page : 5 of 5

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 16, 2009

/David E. A. Jordan/
David E. A. Jordan
Reg. No. 50,325

Fish & Richardson P.C.
PTO Customer No. 26192
Telephone: (202) 783-5070
Facsimile: (877) 769-7945